

REMARKS

Applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 1, 4 and 8-11 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1-11 and 31 are pending.

35 U.S.C. §112 Rejections

The Office Action rejects claims 1-11 and 31 under 35 U.S.C. §112, ¶2 as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action alleges that recitation of a “first direction” and a “second direction” in relation to the first permanent magnet block and recitation of a “first direction” and a “second direction” in relation to the second permanent magnet block renders the meaning of “first direction” and “second direction” indefinite. For at least the following reasons, Applicants traverse this rejection.

Currently amended independent claim 1 recites in a salient portion (emphasis added):

“restraining movement of the second permanent magnet block in at least a **third** direction...; and,

further restraining movement of the second permanent magnet block in at least a **fourth** direction.”

Dependent claims 4 and 8-10 are also amended to include consistent references to the third and fourth directions. Applicants submit that references in amended claim 1 to a **third** and **fourth** direction further distinguish the restraining of movement of the first permanent magnet block from the restraining of movement of the second permanent magnet block. Therefore, the claims as amended distinctly claim the subject matter of the invention. Accordingly, Applicants request that the rejection of claims 1-11 and 31 under 35 U.S.C. §112, ¶ 2 be withdrawn.

35 U.S.C. §102 Rejections

35 U.S.C. §102(b) Rejection over Baermann

The Office Action rejects claims 1, 2, 4, 5, 8-11 and 31 under 35 U.S.C. §102(b) as being anticipated by Baermann, USPN 4,638,281 (*Baermann*). The Office Action alleges that *Baermann* discloses, *inter alia*, the restraining and placement two permanent magnet blocks claimed in independent claim 1. To overcome a 35 U.S.C. §102(b) rejection, Applicants may either demonstrate that the cited document fails to teach one limitation in the rejected claim, or add such a limitation to the claim by appropriate amendment (M.P.E.P. §2131). For at least the following reasons Applicants traverse the above rejection.

Currently amended independent claim 1 recites in a salient portion (emphasis added):

“...placing a second permanent magnet block proximate to the first permanent magnet block, **the placing to form at least part of a magnetic circuit** including the first and second permanent magnet blocks;...”

This amendment is supported in the original disclosure at least by FIG. 5 and by page 9, line 14 through page 10, line 22.

Applicants respectfully submit that the rejected claims are patentable over *Baermann* at least based on independent claims 1, as amended. Specifically, *Baermann* fails to teach a placing of a first permanent magnet block proximate to a second permanent magnet block **to form at least part of a magnetic circuit** including the first and second permanent magnet blocks. The Office Action alleges that in FIG. 1 of *Baermann* disclose a placement of plural magnets 30 which anticipates the present invention. However, **nothing** in either the discussion of FIG. 1 or elsewhere in *Baermann* is the placement of the plural magnets 30 disclosed as forming at least part of a magnetic circuit.

Accordingly, amended independent claim 1 contains at least one limitation not found in *Baermann*, and is patentable over *Baermann*. Furthermore, in depending directly or indirectly from independent claim 1, each of dependent claims 2-11 and 31 incorporate at least one limitation not found in *Baermann*. Therefore, Applicants request that the rejection of claims 1-11 and 31 under 35 U.S.C. §102(b) based on *Baermann* be withdrawn.

35 U.S.C. §102(b) Rejection over Korb

The Office Action rejects claims 1-3 under 35 U.S.C. §102(b) as being anticipated by Korb, USPN 2,855,639 (*Korb*). The Office Action alleges that *Korb* discloses, *inter alia*, the restraining and placement two permanent magnet blocks claimed in independent claim 1. For at least the following reasons Applicants traverse the above rejection.

As discussed in regard to the previous 35 U.S.C. §102(b) rejection over *Baermann*, currently amended independent claim 1 has as a limitation the placement of a second permanent magnet block proximate to a first permanent magnet block **to form at least part of a magnetic circuit** including the first and second permanent magnet blocks. The Office Action alleges that in FIG. 4 of *Korb* anticipates the present invention by disclosing a placement and restraining of plural magnets 25 within a tubular portion 24. However, Applicants submit that *Korb* **fails** to teach a placing of a first permanent magnet block proximate to a second permanent magnet block to form at least part of a magnetic circuit. **Nothing** in either the discussion of FIG. 4 or elsewhere in *Korb* is the placement of the plural magnets 25 disclosed as forming at least part of a magnetic circuit.

35 U.S.C. §102(b) Rejection over *Taneda*

The Office Action rejects claims 1 and 7 under 35 U.S.C. §102(b) as being anticipated by Taneda et al., USPN 5,046,235 (*Taneda*). The Office Action alleges that *Taneda* anticipates the present invention by disclosing a placement and restraining of a first permanent magnet block and a second permanent magnet block in the manner set forth in the rejected claims. Specifically, *Taneda* is alleged to disclose restraining

movement of the first permanent magnet block and the second permanent magnet block with a 3-axis ball screw driven linear slide. For at least the following reasons Applicants traverse the above rejection.

For a 35 U.S.C. §102(b) rejection, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Currently amended independent claim 1 recites in a salient portion (emphasis added):

“...**placing a second permanent magnet block proximate to the first permanent magnet block, the placing to form at least part of a magnetic circuit including the first and second permanent magnet blocks;**

restraining movement of the second permanent magnet block in at least a third direction **otherwise brought about by placing the second permanent magnet block proximate to the first permanent magnet block;...**”

Claim 1 discloses a **placement** of a second permanent magnet block proximate to a first permanent magnet block which, but for a restraint, would induce in the second permanent magnet block a direction of movement. Applicants submit that *Taneda* fails to disclose the identical invention in as complete detail as currently amended claim 1, as set forth in M.P.E.P §2131. Specifically, *Taneda* fails to disclose a restraining of a permanent magnet block from a direction of movement which results from a placement in proximity to another permanent magnet.

Taneda discusses a laminate core 1 having layers of magnetic material. However, rather than indicating that any two layers in laminate core 1 are permanent magnets, col. 4, lines 18-22 of *Taneda*, discloses laminate layers which **have to be energized** to have magnetic polarities. In other words, when any two layers of laminate 1 are **placed** in proximity to one another, **neither layer is a magnet-** particularly a **permanent** magnet, as set forth in the limitations of claim 1-. Insofar as *Taneda* fails to disclose a first and second permanent magnet block being brought into proximity with one another, *Taneda* **further fails** to disclose a direction of motion in one of the permanent magnet blocks- restrained or otherwise- **brought about by the placing** of the other permanent magnetic block into proximity.

The Office Action alleges that claim 1 is anticipated in *Taneda* by the restraining of portions 1L and 1R while the laminate core 1 is bent by an energized coil 2. While neither agreeing that restraint from **bending** anticipates restraint from **movement**, nor agreeing that either bending or movement **brought about by an energized coil 2** anticipates movement **brought about by placement of magnets**, Applicants submit that *Taneda* does **not** disclose any two layers in the laminate core as being **permanent magnets** when restrained. In fact, the Office Action does not point to, nor does *Taneda* contain, any indication that any two layers of laminated core 1 are permanent magnet blocks at any time in the process described.

Accordingly, amended independent claims 1 contains at least one limitation not found in *Taneda*, and is patentable over *Taneda*. Furthermore, in depending directly from independent claim 1, dependent claim 7 incorporates at least one limitation not

found in *Taneda*. Therefore, Applicants request that the rejection of claims 1 and 7 under 35 U.S.C. §102(b) based on *Taneda* be withdrawn.

35 U.S.C. §103(a) Rejections

35 U.S.C. §103(a) Rejection over Baermann

The Office Action rejects claim 6 under 35 U.S.C. §103(a) as being unpatentable over *Baermann*. Specifically, the Office Action relies on the previously discussed 35 U.S.C. §102(b) rejection of claims 1 and 5 over *Baermann*, further alleging that it would be obvious to one of ordinary skill in the art to select a 30 degree difference between the angles of orientation of the first and second permanent magnet blocks.

For at least the reasons set forth in the previous discussion, currently amended independent claim 1 has at least one limitation not set forth by *Baermann*. In rejecting claim 6, the Office Action does not offer any further basis for alleged obviousness of either independent claim 1 or dependent claim 5. Applicants assert that amended independent claims 1 contains at least one element which is nonobvious in light of *Taneda*, and is patentable over *Taneda*. Quoting M.P.E.P § 2143.03:

“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

Accordingly, claim 6 is nonobvious in light of *Taneda*. Therefore, Applicants request that the 35 U.S.C. §103(a) rejection of claim 6 under 35 U.S.C. §103(a) based on *Taneda* be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-11 and 31 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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